

## REMARKS

### Status of Claims

The Office Action mailed July 7, 2006 has been received and reviewed. Each of claims 1, 3-9 and 11-14 stands rejected. Reconsideration of the present application in view of the following remarks is respectfully requested.

### Rejections under 35 U.S.C. § 103(a)

#### A.) Applicable Authority

A patent application's claimed invention is obvious when the differences between the claimed invention and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. 35 U.S.C. § 103; See, also, *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966).

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP §2143 through §2143.03. In order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

*See* MPEP §2143. Further, in establishing a *prima facie* case of obviousness, the initial

burden is placed on the Examiner. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985).” *Id.* See also MPEP §706.02(j) and §2142. Accordingly, the reason, suggestion, or motivation to combine prior art references may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665 (Fed. Cir. 2000). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

B.) Obviousness Rejections Based on U.S. Patent No. 6,473,102 issued to Rodden et al. (hereinafter “Rodden”) in view of U.S. Patent No. 6,581,020 issued to Buote et al., (hereinafter “Buote”).

Claims 1, 3-9 and 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodden in view of Buote. As Rodden and Buote, whether taken alone

or in combination, fail to teach or suggest all of the limitations of claims 1, 3-9 and 11-14, Applicants respectfully traverse this rejection, as hereinafter set forth.

As an initial matter, prior-art references that are contradictory, or teach away from each other or the claimed invention should not be combined to support a prima facie case of obviousness. *In re Bell*, 991 F.2d 781, 784, (Fed. Cir. 1993). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant or if the reference suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. *In re Gurley*, 27 F.3d 551, 553, (Fed.Cir.1994). If when combined, the references would produce a seemingly inoperative device, then they teach away from their combination. *In re Sponnoble*, 405 F.2d 578, 587 (C.C.P.A. 1969); See also *In re Gordon*, 733 F.2d 900, 902, (Fed.Cir.1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

Rodden and Buote teach away from each other. Rodden, column 4, lines 43-47, teaches away from Buote because the determination disclosed by Rodden involves looking for a specified designation that keeps a window on screen and calculating both a preferred size and position for a window having the specified designation. This disclosure of Rodden is in clear conflict with Buote's express disclosure in column 11, lines 15-20 where all windows are displayed in maximized mode, when a display mode is 600X800 and when the display mode is higher than 600X800 the windows are locked and in window-mode, which means that the windows cannot be resized. Because of the noted

conflict, if Rodden is modified according to the constraints disclosed by Buote, then Rodden would no longer be operable to alter a window's size or position when an event that effects content being displayed on the desktop occurs. A skilled artisan would be discouraged from the alleged combination because Rodden's window management routine would be inoperable for its intended purposes.

Moreover, Rodden and Buote teach away from the claimed invention. The claimed embodiments require, among other things, maximizing a window when the size and position are not specified and the screen resolution is below a predetermined threshold (See, e.g., claims 1, 8 and 14). Rodden, column 4, lines 10-60, discloses a window management system that automatically repositions or resizes windows having a specified designation when one or more events, such as screen configuration changes that effect the display of content occur. On the other hand, Buote, column 11, lines 1-30, discloses window constraints that provide a consistent look for major functional screens. A reasonable reading of Rodden and Buote, singularly or in combination does not fairly suggest, teach or provide a motivation for the claimed maximization of windows when the size and position are not specified and the screen resolution is below a predetermined threshold.

Accordingly, Rodden and Buote teach away from each other and the claimed invention, and the 35 U.S.C. § 103(a) rejection of claims 1, 3-9 and 11-14 should be withdrawn.

The Examiner contends that the remarks attack the references individually and cites *In re Keller*, 642 F.2d 413 (C.C.P.A. 1981). Applicants respectfully disagree. *Keller* held that a pacemaker having a digital timer was obvious in view of a prior-art

pacemaker having an analog timer. The court found that the secondary reference suggested that digital timers were preferable to analog timers because of the accuracy associated with digital timers. The court reasoned that bodily incorporation of the circuitry disclosed by the secondary reference was not necessary where the primary references provided all other requirements of the claimed pacemaker and the secondary reference was relied on only for suggesting that digital timers may be replaced by analog counters in an analogous environment.

Unlike *Keller*, the instant obviousness rejection does not meet all requirements of the claimed invention. The prior-art references, even if combined, do not fairly teach, suggest or provide a motivation for the claimed displaying of a maximized window when the size and position are not specified. Here, Buote and Rodden are concerned with different problems. Rodden, column 1, lines 10-15, is concerned with maintaining a preferred position or size for designated windows in response to one or more screen configuration events. In an unrelated field of data management for laboratory or pharmaceutical products, Buote, column 1, lines 5-10, provides a user interface design that generates a consistent look for major functional screens for the data management system, column 11, lines 1-5. Accordingly, neither Buote nor Rodden teaches, suggests or provides a motivation for the claimed window maximization method. Accordingly, the alleged combination of the unrelated references, Buote and Rodden, can not be the basis for a *prima facie* case of obviousness.

Even if combined, Rodden and Buote fail to disclose, the claimed requirement of claims 1, 8 and 14.

With respect to independent claim 1, Rodden and Buote, fail to teach or suggest, among other things, “determining, for the window, whether a display size and display screen position are specified for the window . . . if a size and position are specified, rendering the window at the specified size and in the specified position, so that the window is not automatically maximized.”

The Office contends that Rodden teaches column 1, lines 58-59 and column 4, lines 32-47 discloses the claimed determining if the display size and position are specified and rendering at the corresponding size and position. The Office indicates that the cited portions illustrates that a “user selectively specifies certain windows to be displayed at a specified size and position for different resolutions.” Applicants respectfully disagree. The cited portions expressly indicate that the user designates a window as “keep visible.” There is no discussion about the user further designating a size or position. Rather, the size and position are re-calculated as indicated by FIG. 5 and column 4, line 45-column 5, line5. Moreover, Rodden does not disclose that the windows are rendered in a non-maximized state at the specified size and position when the window size and position are specified.

Similarly, Buote fails to disclose the claimed requirement for generating the non-maximized window. Buote, column 11, lines 15-20 discloses window constraints where all windows are maximized at a 600X800 resolution. However, there is teaching or suggestion to render a non-maximized at a specified size and position. While Buote does disclose window-mode windows there is no indication that a size and position are checked when rendering the window-mode windows.

Unlike Buote and Rodden, individually or in combination embodiments, of the present invention provides selective maximization based on screen resolution and whether a window size and position are specified. Accordingly, the obviousness rejection of claim 1 should be withdrawn.

Claims 3-7 depend from claim 1 and further define novel features of the claimed invention. Accordingly, claims 3-7 are allowable over Buote and Rodden for at least the reasons set forth above with respect to claim 1.

With respect to independent claim 8, Rodden and Buote, fail to teach or suggest, among other things, “automatically maximizing the size of the window on the display screen if the current screen resolution is below the selected resolution threshold, wherein the current screen resolution does not change.”

The Office concedes that Rodden fails to teach the claimed requirement of automatically maximizing the size of the window. However, the Office contends that Buote column 11, lines 15-21 discloses the claimed automatic maximization. Applicants respectfully disagrees. The cited portion of Buote detail uniform maximization when the screen resolution is 600X800. However, unlike Buote the claimed embodiment expressly indicates that window maximization occurs when a size and position are not specified and the current screen resolution is below a specified threshold.

Contrary to the Office’s contention, both Rodden and Buote fail to teach, suggest or provide a motivation for the claimed selective window maximization. The claimed embodiments of selective window maximization expressly requires, that window size and position not be specified and the current threshold be below a predetermined threshold.

The prior art, including Rodden and Buote fail to disclose the claimed requirements of claim 8. Accordingly, the obviousness rejection of claim 8 should be withdrawn.

Claims 9 and 11-13 depend from claim 8 and further define novel features of claimed embodiment. Accordingly, for at least the reasons set forth above with respect to claim 8, the obviousness rejection for claims 9 and 11-13 should be withdrawn.

With respect to independent claim 14, Rodden and Buote, fail to teach or suggest, among other things, “automatically rendering the window in a maximized size on the display screen, if the window is capable of being maximized and determining if the restore button has been initiated when the window is a maximized size; and reducing the size of the window on the display screen by a pre-determined amount, if the restore button has been initiated.”

The Office contends that Rodden inherently teaches the claimed restore button that is functional when the window is a maximized state. The Office contends that Rodden inherently teaches a restore button. However, the Office fails to provide a column or line to indicated where Rodden provides the inherent teaching of the claimed restore button. Applicant’s respectfully request clarification on the inherent teachings of Rodden with respect to claimed restore button.

The Office then argues that Buote also discloses the claimed restore button. Applicant’s respectfully disagree. Buote, column 11, lines 25-30 expressly indicated that the windows do not have a maximize button. As detailed above Buote details two modes of operation maximized when the resolution is 600X800 and window-mode when the resolution is above 600X800. In the maimed state or window-mode, Buote does not

disclose the claimed restore button. At best Buote, column 11, lines 25-30 and FIG. 4 discloses a back button and a minimize button.

Unlike Rodden and Buote, the claimed embodiment provides a maximized window with a restored button that reduces the size of the maximized window by a predetermined amount. The disclosures of Rodden and Buote do not fairly teach suggest or provide a motivation for the claimed restore button. Accordingly, the obviousness rejection of claim 8 should be withdrawn.

## CONCLUSION

Claims 1, 3-9, and 11-14 are pending in this application. In view of the remarks, applicants respectfully request that this application be allowed and passed to issue. Should any issues remain prior to issuance of this application, the Examiner is urged to contact the undersigned prior to resolve the same. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112 referencing Attorney Docket No. MFCP.81059.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response. Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 19-2112 (Attorney Docket No: MFCP.81059).

Respectfully submitted,

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